

RCE & AMENDMENT
Serial No. 10/612,079
Docket No. ORW01-GN003

Applicant's claims, one skilled in the art must be motivated to do so. But those skilled in the art would not have been motivated to modify Ferguson. If anything, Ferguson teaches away from Applicant's claims.

Those portions of Ferguson cited to by the Examiner teach a structure entirely at odds with the structure claimed by Applicant. Ferguson teaches using a resorbable material connected to a patient's native connective tissue to spur on native connective tissue growth that connects bone to the tibial prosthetic component.⁹ But Applicant is not at all interested in forming connective tissue that couples soft tissue to a prosthetic component. If anything, Applicant wants to avoid coupling soft tissue between joints to prosthetic components. Ferguson, on the other hand, is directed to the exact opposite situation and teaches those skilled in the art of a preference for using resorbable materials to form bridges that are mounted to connective tissue and transform into soft tissue connecting to certain prosthetic components.¹⁰ In this regard, Ferguson, if anything, clearly teaches away from Applicant's claims. If the Examiner disagrees, Applicant respectfully requests the Examiner point to the disclosure of Ferguson stating that the resorbable lining not mounted to native connective tissue.

Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections of record over Ferguson in combination with Scarborough for claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61, and 62 are respectfully requested.

Claims 23-25 and 27-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson"). This ground of rejection is now moot in view of the cancellation of these claims.

Withdrawal of the 35 U.S.C. § 103(a) rejection of record over Ferguson for claims 23-25 and 27-32 are respectfully requested.

⁹ See U.S. Patent No. 6,592,622 at column 5, lines 1-59.

¹⁰ See U.S. Patent No. 6,592,622 at column 1, lines 7-9, TECHNICAL FIELD OF THE INVENTION section, "The present invention relates generally to a prosthesis, and more particularly to an apparatus and method for securing soft tissue to an artificial prosthesis."

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Claim 26 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson") in view of U.S. Patent No. 6,461,320 to Yencho et al ("Yencho"). This ground of rejection is now moot in view of the cancellation of this claim.

Withdrawal of the 35 U.S.C. § 103(a) rejection of record over Ferguson for claim 26 is respectfully requested.

Claims 63, 65-76 and 105 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Reissue No. 29,757 to Helfet ("Helfet") in view of U.S. Patent No. 5,759,205 to Valentini ("Valentini"). This ground of rejection has been fully overcome by the amendments to claim 63 and is traversed with respect to claim 105.

Claim 63 has been amended to recite, at least in part, a lining mounted to at least one of the stabilizing post and an inner surface of the femoral component at least partially defining the prosthetic intercondylar channel, and remote from native connective tissue, to, at least temporarily, supplement periarticular stability between the stabilizing post and the prosthetic intercondylar channel, the lining comprising a biologically reabsorbable lining material. Neither Helfet, nor Valentini, disclose a biologically reabsorbable lining material mounted to at least one of the stabilizing post and an inner surface of the femoral component at least partially defining the prosthetic intercondylar channel, which is remote from native connective tissue. For this reason alone, claim 63 is in condition for allowance. Likewise claims 65-76 depending from claim 63 are also in condition for allowance, as Helfet and Valentini fail to disclose all of the claimed limitations of these claims. Similarly, claim 105 includes limitations not taught or suggested by Helfet or Valentini.

Second, the prior art method of operation of Valentini contradicts the alleged suggestion or motivation to modify Helfet. M.P.E.P. § 2143.02 provides in relevant part:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (C.C.P.A. 1959).

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The Office action alleges on page 4 that the motivation to combine Valentini with Helfet is:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a coating or lining of biodegradable material in the Helfet prosthesis, as taught by Valentini, *to promote implant incorporation into a patient's body.*

But the *intended use* of the coating or lining of Valentini is to *permanently bond*, in a fixed position, the prosthetic device to native tissue (such as bone). This is anything *but* the intended use of Applicant's invention or of any repositionable joint.

It is simply illogical to assert that those skilled in the art would want to coat a prosthetic joint with a compound known to inhibit movement by bonding the prosthetic joint to the native tissue by using the coating of Valentini. One of the intended uses of any prosthetic joint is mobility, which is clearly at odds with the disclosure of Valentini, and is why one skilled in the art would not look to the coatings of Valentini to achieve this goal. If anything, those skilled in the art would avoid using the coatings of Valentini.

If a proposed modification would render the prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.¹¹ In this case, the low friction platform 19 of Helfet is not intended to be eroded and replaced by the metal base 18, which is exactly what would happen if a biodegradable material of Valentini is used in lieu of the low friction plastic. If the plastic platform 19 were quickly eroded, the condyles 22, 24 (which are metal) would ride upon the metal base 18. This adverse situation is exactly the reason that Helfet requires one of the two replacement components to be plastic, and the opposite component be metal in order to avoid metal-on-metal contact. In other words, the alleged combination renders Helfet unfit for its intended purpose. Thus, the recited rationale in the Office action for combining the references is objectively illogical and boils down to nothing more than impermissible pure hindsight. On this ground alone, the rejection of claims 63, 65-76, and 105 under 35 U.S.C. § 103(a) is untenable.

¹¹ See M.P.E.P. § 2143.01, Section V, citing *In re Gordon*, 733 F.2d 900 (Fed. Clr. 1984).

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Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of record for claims 63, 65-76, and 105 are respectfully requested.

Allowable Subject Matter

Applicant acknowledges the determination that claim 64 is allowable. In light of the grounds of rejection recited in the Office action and the due consideration the Examiner will give to Applicant's amendments, Applicant has refrained from prematurely rewriting this claim in independent form.

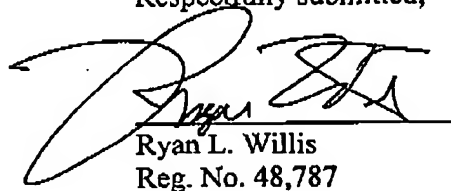
Conclusion

In light of the foregoing, it is respectfully submitted that claims 41-46, 48-76, and 105, now pending, are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejections of record are respectfully requested.

The Commissioner for Patents is hereby authorized to charge any additional fees that may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

In the event that the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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